

Item 5 in the office action indicates that the title is not descriptive. As indicated in the Field of the Invention and the Discussion of the Background sections of the application, the relevant field of the invention is product sampling. Accordingly, the applicant proposes the title "A System and Method for Product Sampling". The examiner is, of course, free to provide a title deemed suitable.

Item 7 of the office action identifies the improper citation to "central computer 204" on page 11. In response, page 11, lines 12 and 19 have been amended to refer to central computer 206.

Item 8 in the office action identifies a grammatical impropriety on page 12. In response, page 12, line 14 is amended to delete "identifiable".

Item 9 in the office action points out that the recitation on page 6, lines 19-21 are inconsistent with Figure 3. In response, page 6, lines 19-23 have been amended to correspond to Figure 3.

Item 10 in the office action requires correction of the word "by" to "buy" on page 15. The specification has been amended accordingly.

Items 12-18 identify rejections and reasons therefor under the second paragraph of 35 USC 112 for claims 4, 19, 22, 29, and 30.

In response, claim 22 has been amended to refer to system claim 16.

Item 17 asserts that "said product" recited in claim 4 is unclear. Applicant disagrees. However, for the sake of convenience, applicant amends that expression to "a product for which instructions for providing said sample of said product are generated" since clear antecedent for that recitation appears in the step of "generating" recited in claim 1.

Item 18 makes the same assertions for claim 19 that item 17 makes for claim 4. In response, claim 19 is amended in the same fashion and for the same reasons as claim 4.

In numbered item 24, the office action rejects claim 1, 2, 3, 5, and 18 based upon United States Patent 6,141,010 to Hoyle. The applicant traverses those rejections for the following reasons.

First, those rejections rely upon the assertion that Hoyle teaches prompting "a user to provide profile data including identification of the user from a main computer of a computer network to a network address for the user's computer." Office action page 4 lines 17-18. That assertion is clearly incorrect, as evidenced by Hoyle column 2 lines 32-43 (in teaching away from attempting to have users provide their addresses in identifications), column 5 line 26 (Hoyle a system "providing a unique identifier to the computers"), and column 17 lines 26-44 (indicating that Hoyle's system provides its own anonymous identification to either a software program or a computer). Thus, Hoyle does not teach prompting a user to provide an identification, and Hoyle does teach away from prompting a user to provide an identification. In contrast to Hoyle, independent claim 1 recites "transmitting a signal prompting a user to provide profile data including identification of the user...". Independent claims 16 and 31 contain identical limitations. Accordingly, no claim in this application is anticipated by Hoyle.

The office action impliedly asserts that free software downloads are free product samples, stating that "the use of banner ad, cookie or a scrolling text at the bottom of a viewing page to prompt a user to visit a site for information regarding free product samples, such as free software download..." at page 5 lines 2-4. The specification of this application indicates that product sampling may be for products that are (1) consumer packaged goods (page 1 line 22) and (2) products that require packing and shipping (page 1 line 25). Since the examiner deems the independent claims to read upon free software downloads, the applicant is amending by adding dependent claims defining the two types of products

identified above. See claims 32-37.

The second paragraph of claim 1 defines transmitting an offer for a sample depending upon user's profile data. The office action appears to equate this to functions provided by commercial services Netero, Lycos, and Juno. Office action page 5 lines 5-8.

In response, the applicant points out that those commercial services are not or have not been shown to be embodiments of the invention disclosed in Hoyle. Accordingly, even if the assertions were correct, the rejection under 35 USC 102 would be improper.

Moreover, there is no evidence of record that Hoyle, NetZero, Lycos, or Juno provides manufacturer's sample offers, that Hoyle, NetZero, Lycos, or Juno uses user profile data to determine whether or not to present manufacturer's sample offers to users, which limitations are defined in the "transmitting a manufacturer's sample offer" paragraph in claim 1. Hence, rejection under 102 is improper and no evidence of record would support rejection under 103.

With respect to the "generated" step recited in claim 1, the office action asserts that "an e-mail could be sent to the user." Office action page 6 lines 9-10.

In response, the applicant points out that the office action has not identified that Hoyle discloses sending an e-mail to the user, and it does not appear to the undersigned that Hoyle discloses sending an e-mail to the user. Moreover, and more importantly, sending an e-mail to the user would not meet the limitation recited in claim 1 of "generating instructions for providing said sample of said product to said user". Hence, this assertion does not support rejection.

Claims 16 and 31 are system and program product analogs of independent claim 1. Accordingly, for all of the reasons presented above with respect to claim 1, the rejections of independent claims 16 and 32 as anticipated by Hoyle are improper and should be withdrawn.

Since Hoyle does not disclose or suggest providing manufacturer's sample offers, it also does not disclose or suggest the determining step recited in claim 2, and the determining step recited in claim 3.

For these additional reasons the rejection of dependent claims 3 and 4 should be withdrawn.

Since claim 5 depends from claim 1, the rejection based upon Hoyle of claim 5 should be withdrawn.

The office action rejects claims 4, 6-10, 12-15, 19-25, and 27-30 as obvious in view of Hoyle.

The office action admits in item 37 that Hoyle does not teach determining if the user purchases the product, as recited in claims 4 and 19. The office action relies upon official notice that product manufacturer's require consumers to register an item purchased from a vendor. Office action page 11 lines 8-10.

In response, the applicant traverses this assertion because (1) it is not based upon prior art evidence and (2) the applicant disputes that "product manufacturer's usually require consumers to register any item purchased from a vendor."

The office action in item 38 alleges that determining if the user purchased a product for which the user previously received a sample of the product (which is what is defined by claims 4 and 19) would have been obvious. However, that conclusion is not followed from the alleged facts. Hoyle does not disclose product sampling, and therefore it does not disclose that a user's profile data contains data indicating products the user has sampled, and therefore there is no basis to conclude that it would have been obvious to match product purchase data to product sample data. For the same reasons, claims 15 and 30 would not have been obvious in view of Hoyle.

Claims 7, 8, 22, and 23 would not have been obvious in view of Hoyle because Hoyle teaches away from attempting to capture the actual address or personal identification information for a user.

The office action at item 39 admits that Hoyle does not disclose the subject matter additionally defined by dependent claims 14 and 29.

In item 40 the office action admits that the additional subject matter defined by dependent claims 9, 10, 24, 25 is not disclosed or suggested by Hoyle. There is no evidence supporting the conclusion in the office action at page 13 lines 17-21 that the subject matter defined by those claims would have been obvious.

The office action in item 41 rejects dependent Claims 11, 17, and 26 as obvious based upon Hoyle in view of United States Patent No. 5,185,695 to Pruchnicki.

Hoyle is directed to a browser-based advertising system. Pruchnicki is directed to a point-of-sale accounting system. There is simply no relation between these two systems which would suggest to one of ordinary skill in the art that they could be combined in any comprehensible fashion. In this regard, the office action asserts that it would have been obvious to combine elements of Pruchnicki's system and Hoyle's system, specifically to use the add server 50 to somehow provide advertising to a user at a point-of-sale location in a store. However, that makes no sense, since the customer of Pruchnicki's system merely passes by the point-of-sale terminal when purchasing goods sold at a store, and therefore the functionality associated with Hoyle's browser system would provide no utility at the point-of-sale terminal because the user has no incentive to "browse" when at checkout, the user has already collected all intended purchase when at checkout, and browsing at checkout would slow down any checkout line.

Moreover, and more importantly, even if it were reasonable, what is proposed as a

combined system in item 43 in the office action would not perform the step recited in claim 11, since that step is expressly dependent upon whether the "main computer had received said signal indicating said user involved in said transaction had accepted said manufacturer's sample." Note that Pruchnicki's system provides manufacturer's discounts to any and every person purchasing a product for which said discount is available. Hence, there is no dependency in Pruchnicki's system upon accepting the manufacturer's sample. Accordingly, the proposed combination, involving Pruchnicki's point-of-sale discount, would not meet the dependency defined in the step of transmitting recited in claim 11.

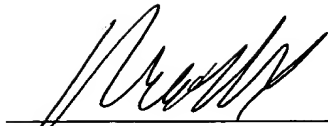
The office action asserts in item 44 that it would have been obvious to include fields in a database including user profile data based upon the proposed combination of the Pruchnicki and Hoyle systems. However, Pruchnicki does not disclose requiring identification from people making purchases. Since no identification is provided at checkout, there would be no basis to update "user profile data." For that additional reason, the rejection of claim 11 is improper and should be withdrawn.

Claim 26 contains means recitations corresponding to the recitations in claim 11 and is not obvious over the applied references for the same reasons applying to claim 11.

The combination rejections of claim 17 should be withdrawn because there is no motivation for the combination and also because the combination does not provide a means to identify the customer, which is required in order to determine if the user's "profile data meets said user profile criteria..." as recited in claim 17.

In view of the foregoing comments, reconsideration and allowance of this application is requested.

Respectfully submitted,


Richard Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

3-14-01
Date



22850

(703) 413-3000
Fax #: (703) 413-2220
RAN:cct:rlb

RECEIVED
MAR 22 2001
Technology Center 2100

I:\atty\RAN\clients\CATALINA\77910081\77910081-am.wpd

Marked-Up Copy
Serial No: <u>09/418,509</u>
Amendment Filed on: <u>March 16, 2001</u>

IN THE SPECIFICATION

Please amend the specification as follows:

Page 5, please replace the paragraph beginning at line 19 with the following text:

--The computer network 200 of Fig. 2 includes the computers 100 (not shown) [of], a plurality of users 202, 202b, 202c, a communications system 204, and a central computer system 206 which also includes a computer such as computer 100. The methods of the present invention is implemented using the computer network 200, the central computer 206, and one or more of the computers 100.--

Page 6, please replace the paragraph beginning at line 18 with the following text:

--Step 1 illustrates a response to a banner or a cookie. Steps 2 and 3 show a user 202, 202b, 202c whose computer 100 is connected to the Internet responding to a banner advertisement or accessing a website having an online registration [as shown in step 3]. Thus, in [step 1] steps 1-3, the user 202, is invited to register to participate in a sample product distribution program via data transmitted over the computer network 200. The user 202's computer interprets the data by displaying an invitation to register. In a preferred environment, the user 202, uses a personal computer 100 to access the communication system 204. Alternatively, the user may use a personal digital assistant, a cellular telephone, or a kiosk, instead of the personal computer 100 to connect to the communication system 204.--

Page 11, please replace the paragraph beginning at line 9 with the following text:

--Step 18 illustrates delivering the product samples to the users via standard U.S. mail, foreign country postal service or a third party delivery service. The sample delivery process is typically handled by a mailing/fulfillment company. The delivery instructions are preferably provided by the central computer [204] 206 to the fulfillment company via transmission of an electronic file including the participating names and corresponding addresses.--

Page 11, please replace the paragraph beginning at line 19 with the following text:

--In step 27, the central computer [204] 206 instructs a printer or a plurality of printers (not shown) to print coupons to be distributed to the targeted users via the postal mail.--

Page 12, please replace the paragraph beginning at line 11 with the following text:

--In step 32, selected users visits the participating store and select the designated product. Selected users must present their shopper cards containing their unique identification and present the designated product at the point-of-sale. The designated product is identified uniquely [identifiable], typically by a UPC code.--

Page 14, please replace the paragraph beginning at line 23 with the following text:

--Moreover, the consumer may be targeted for an incentive based upon the data stored in either or both of the post sampling product purchase database 208 and the post-delivery consumer survey database 214. Furthermore, identifying why the consumer did not [by] buy the product will allow the manufacturer to provide an incentive to the consumer based upon that result. For example, if the consumer indicates that the price was higher than a price of a competing product, the manufacturer may target that customer for a discount based upon the price differential of a competing product. Similarly, the manufacturer may obtain the consumer's preference for package size, shape, and provide an incentive targeted to the consumer based upon the consumer's preferred package style. The incentives can be

communicated to the customer in a variety of ways, including via email messages, via a Web page, and via normal mail.--

IN THE CLAIMS

Please amend the claims and add new claims as follows

--4. (Amended) The method of claim 1, further comprising the step of:
determining if said user purchases [said] a product for which said instructions for providing said sample of said product are generated.

16. (Amended) A computer network system, comprising:
a main computer, said main computer configured:
to transmit a signal prompting a user to provide profile data including identification of the user from over a computer network to a network address for the user's computer;
to transmit a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and

to generate instructions for [provide] providing said sample of said product to said user in response to receipt of a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

19. (Amended) The system of claim 16, further comprising:
means for determining if said user purchases [said] a product for which said main computers configured to generate instructions for providing said sample of said product.

22. (Amended) The system of claim [1] 16, further comprising;
means for transmitting a signal prompting said user to provide said user's postal

mailing address.

29. (Amended) The [method] ~~system~~ of claim 28, further comprising:

means for determining consumer conversion based at least in part on said purchase data stored in said consumer database.

30. (Amended) The [method] ~~system~~ of claim 28, further comprising:

means for transmitting said manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer only if said user's profile data meets said user profile criteria and said purchase history data meets purchase history criteria associated with said manufacturer's sample offer for said sample of said product.

--32. (New) The method of claim 1, wherein said step of transmitting a manufacturer's sample offer for a sample of a product comprises transmitting a manufacturer's sample offer for a sample of a packaged good product.

33. (New) The system of claim 16, wherein said main computer is configured to transmit a manufacturer's sample offer for a sample of a packaged good product.

34. (New) The product of claim 31, wherein said means for performing said step of transmitting a manufacturer's sample offer for a sample of a product comprises means for transmitting a manufacturer's sample offer for a sample of a packaged good product.

35. (New) The method of claim 1, wherein the step of generating instructions for providing said sample of said product to said user comprises generating instructions for packing and shipping the sample of the product to said user.

36. (New) The system of claim 16, wherein said main computer is configured to generate instructions for packing and shipping the sample of the product to said user.

37. (New) The product of claim 31, wherein said means for performing said step of generating instructions for providing said sample of said product to said user comprises means for generating instructions for packing and shipping the sample of the product to said user.--